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Commissioner For Patents and Trademarks, Alexandria, Virginia 22313-1450

6/6/04

9 pages-including this cover letter

From:

Bruce A. Rosenthal fax:212 460-8897

(phone number: 212 254-1028)

Re:Appn. No. : 10/677,589 AU 2873 ; Examiner R. Mack

Following:

RESPONSE TO ELECTION REQUEST (mailed by PTO 5/6/04)

Please fax back to me - indicating receipt of this transmission-

To : 212 460-8897.

(if trouble faxing, please phone: 212 254-1028)

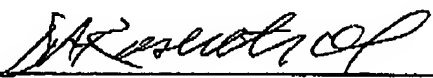
Thank you. Sincerely,

Bruce A. Rosenthal

CERTIFICATE OF FACSIMILE TRANSMISSION

Fax No.

I hereby certify that this correspondence is being sent by facsimile-transmission to the Commissioner For Patents and Trademarks, Alexandria, Virginia 22313-1450 on June 4, 2004.


Bruce A. Rosenthal

FROM :

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Jun. 04 2004 12:45PM P2

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appn. Number: 10/677,589
Filing Date : 7/22/98
Applicant : Rosenthal, Bruce A.
Examiner : Mack, R. / AU 2873

Sent by Fax: 703 872-9306

2004, June 4

RESPONSE TO ELECTION REQUEST

Commissioner For Patents and Trademarks
Alexandria, Virginia 22313-1450

This is in response to Office Action containing an Election/Restriction; mailed
May 6, 2004.

In the Office Action, the Examiner established a restriction to: Group I: Claim 1,
or Group II: Claims 2-20.

The Examiner further detailed an election required among species in Group II:

Species I, claims 2-5, 12-15 and 20.

Species II, claims 6-7.

Species III, claims 8, 16 and 18.

Species IV, claims 9 and 19.

Species V, claims 10 and 17.

Application/Control Number 10/677,589**ROSENTHAL, BRUCE A. p.2**

The process claims 2-9 of the present application 10/677,589 were originally filed on 1/18/95, in application 09/375,405, as claims 26 -33. Claims 26 -33, being part of an application consisting of claims 1- 33, There was an election restriction on 3/19/96, requiring the selection of one of 6 Groups, of which Group VI, contained the process claims 26-33, (which in the present application 10/677,589, correspond to numbered claims 2 -9). These claims weren't separated out previously by the examiner. Therefore, it is respectfully submitted that they not be separated out now into separate patent applications

Furthermore, in an Election Restriction in a second continuation in the series of applications, the Examiner again established the same Group of process claims as a Group of claims to be examined together.

Also, it is respectfully submitted that as claims 12-20 are all dependent on the independent claim 11, that these claims should be examined together.

It is believed that any search for the species involved in any of the process Species within Group II, such as Species I, claims: 2-5, 12-15 and 20, would necessarily include a search of the species of the remaining species claims. Thus a simultaneous search for all of these claims, in this case, is believed NOT to constitute an unreasonable search for the patent examiner.

Application/Control Number 10/677,589**ROSENTHAL, BRUCE A. p.3**

In addition, it is believed that the objectives of streamlined examination and compact prosecution would be promoted if a search were conducted simultaneously for all claims.

Furthermore, the necessity of filing additional multiple patent applications in this case, does not serve to promote the public interest because of the extra expense that is involved in filing fees, in examination costs, as well as the burden upon the public due to the necessity of searching through a multiplicity of patent files, in order to find a complete range of subject matter claimed in several different patents, that would otherwise be found in a single issued patent.

In addition, the Pro Se inventor has already been required to break his patent down into multiple groups which has already put a considerable burden on the ProSe individual inventor. Also, this process starting with the inventor's original application has already taken 9 years of substantial work. This has already been a hardship for the inventor, and nearly half of the potential benefit years of the process claims of the inventor's application have already been consumed.

The Pro Se inventor would greatly appreciate any assistance the examiner might provide, including phoning the applicant, prior to making any decision which could require the applicant to further divide claims 26-33 of his original application "Group 6" of March 19, 1996. .

Application/Control Number 10/677,589**ROSENTHAL, BRUCE A. p.4**

If the applicant has to further divide the processes into more patent applications beyond the multiple applications he has already had to file, the applicant is hopeful that the examiner can see a way to at least keep the processes of the originally filed claims, (as restricted and mailed on March 19, 1996; Group VI, claims 26-33), which in this application 10/677,589 correspond to numbered claims 2 -9.

(A copy of the office action mailed on March 19, 1996, is attached for your convenience.)

In the Office Action of May 6, 2004, on page 3, par. 6, the Examiner has stated:


"Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 11 is generic."

While the Examiner has specified claim 11 as being in Group II, the Examiner has not specifically identified claim 11 as an election in the list of choices of claims in Species I - V of Group II.

ELECTION:

If the election requirement is maintained, the applicant elects Group II, Species I, claims 2-5, 12-15 and 20, with traverse. The applicant would also like the Examiner to examine generic claim 11.

Sincerely,


Bruce A. Rosenthal, Applicant Pro Se; (phone:212 254-1028)

FROM :

FAX NO. :

Jun. 04 2004 12:46PM P6


**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

 Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/375,405	01/18/95	ROSENTHAL	
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B

EXAMINER

MACK, R

25M1/0319

 BRUCE A. ROSENTHAL
6 BULFAIRE RD.
EAST ROCKAWAY, NY 11518

ART UNIT

PAPER NUMBER

2516

DATE MAILED:

03/19/96

 This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined. ☐ Responsive to communication filed on _____ ☐ This action is made final.
 A shortened statutory period for response to this action is set to expire ZERO (0) month(s), 30 days from the date of this letter.
 Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-848. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claim(s) 1-33 are pending in the application.
Of the above, claim(s) _____ are withdrawn from consideration.
2. ☐ Claim(s) _____ have been canceled.
3. ☐ Claim(s) _____ are allowed.
4. ☐ Claim(s) _____ are rejected.
5. ☐ Claim(s) _____ are objected to.
6. ☒ Claim(s) 1-33 are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawing(s) under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawing(s) are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-848).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction(s), filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

PTOL-326 (Rev. 11-94)

Serial Number: 08/375,405
Art Unit: 2516



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Part III DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1, 2, 5, 6, 10 and 11, drawn to focus and defocusing characteristics, classified in Class 359, subclass 626.

Group II. Claims 3, 4, 7-9 and 18-23, drawn to surface composed of lenticular element, classified in Class 359, subclass 619.

Group III. Claims 12-14, drawn to holographic system or element, classified in Class 359, subclass 1.

Group IV. Claims 15-17, drawn to lenticular fresnel lens, classified in Class 359, subclass 457.

Group V. Claims 24 and 25, drawn to variable reading exhibitor with lenticular lens, classified in Class 40, subclass 454.

Group VI. Claims 26-33, drawn to a method of printing, classified in Class 355, subclass 77.

2. Inventions I through VI disclosed as different combinations which are not connected in design, operation or effect. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP

Serial Number: 08/375,405
Art Unit: 2516

Rosenthal

-3-

806.04, MPEP 808.01). In the instant case the combinations they are distinct among themselves and contain elements that pertain to different functions and different effects.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of the record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

Serial Number: 08/375,405 Rosenthal
Art Unit: 2516

-4-

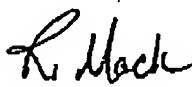
Should the applicant consider these claims to be patentably distinct, he should so state and give reasons therefore. In such case, the examiner will reconsider the restriction requirement and possibly modify same.

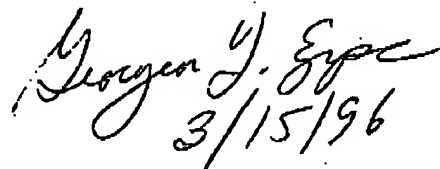
The applicant should note that the examiner would be willing to reconsider the restriction requirement provided an explanation is given as to why the indicated groups of inventions are not patentably distinct from each other. However, should the applicant admit that the indicated groups of inventions listed above are not patentably distinct, then during examination of the elected invention(s), any prior art applied to one invention would also be applied against any inventions considered not patentably distinct therefrom.

The applicant is advised that the response to this requirement to be complete *must include an election* of the invention to be examined even though the requirement be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky Mack whose telephone number is (703) 305-6984.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Ricky Mack
Examiner AU2516
March 14, 1996


3/15/96

GEORGIA Y. EPPS
SUPERVISORY PATENT EXAMINER
GROUP 2500